

## REMARKS

As requested by the Examiner, the drawings and the specification have been amended to refer to slit 55 and side 51. A complete set of formal drawings is included with this Amendment in order to clarify that Figure 7 has not been cancelled. In addition, the language of paragraph 23 has been revised to allay the Examiner's new matter objection as set forth in the Advisory Action. Other portions of the Specification were amended to enhance the clarity thereof. The New Drawing Sheet places numeral 46 directly on the clip's base, and inserts numerals 51 and 55 into Figure 5. An Annotated Drawing Sheet is included herein, with the changes made to Figure 5 indicated in red. Claims 18 and 19 were amended to correct the lack of antecedence for "pressure means". No new matter has been added.

Claims 1 – 4, 8 – 11, 16 – 19, 28, 30, 32 and 33 are pending. Claims 5 – 7, 12, 13, 20 – 22, 24, 25, 27 and 31 have been withdrawn by the Examiner.

**I. Claims 1 – 4, 16 – 19 , 28, 30, 32 and 33 are Novel and Nonobvious over AAPA (FIG. 4) (hereinafter referred to as AAPA)**

Claims 1 – 4, 16 – 19 , 28 -30, 32 and 33 stand rejected under 35 USC 102(b) over AAPA. This rejection is traversed.

**A. AAPA Applies Force to a Central Area of the Tray**

The pending claims are novel and nonobvious over AAPA for at least two reasons. AAPA's clip applies force to the *central area* of a tray stack that results

in damaged trays. Applicants overcome the disadvantage of AAPA by applying a force to the perimeter of a stack as set forth in independent claims 1, 16, and 28:

**Claim 1:** “An apparatus for clamping together in a stack at least one tray... the apparatus comprising ... at least two pressure members”. The pressure members apply a force “on a portion of the *perimeter* of the stack”.

**Claim 16:** “An apparatus for clamping together in a stack at least one tray and a cover, the apparatus comprising ... at least two pressure members”. The “pressure members apply a force in an upward direction relative to the base on a portion of the *perimeter* of the stack....”

**Claim 28:** “An apparatus for clamping together in a stack at least one tray... the apparatus comprising ... at least two pressure members attached to the channel structure for applying a force in an upward direction relative to the base, wherein each pressure member applies pressure on a portion of the *perimeter* of the stack.”

Unlike in AAPA where pressure is applied to a central area of a tray, the current invention applies a force to the perimeter of a tray stack. This distinction by itself suffices to render Claims 1 – 4, 8 – 11, 16 – 19, 28, 30, 32 and 33 patentable.

#### **B. AAPA is Incapable of Applying Pressure to the Perimeter of a Stack**

The Examiner argues that the Admitted Prior Art (Fig. 4) is “capable of performing the intended functions set forth in the claims.” However a function of the claimed invention is to “apply a force ... on a portion of the perimeter of the stack” (Claim 1). Nothing in AAPA shows an apparatus that could apply a force to the perimeter of a stack, even such as the stack postulated by the Examiner. The AAPA clip has curved pressure members. Therefore the force exerted on the stack by AAPA is produced by the peak of the curve, which is in the center of the stack, and not at any portion of the perimeter.

The Office Action states that AAPA's pressure member is capable of applying pressure to a portion of a perimeter of a stack when the AAPA clip is used with a stack having a dimension whose perimeter lies on top of the two pressure members (*note* Office Action, p. 3, paragraph 2). The Examiner's argument relies on an illustration that surfaced for the first time in the May 2006 Office Action (page 5, hereinafter referred to as the After-Filed Figure or AFF). In the After-Filed Figure, a tray stack is illustrated having a perimeter that lies on springs 34. However, Applicant submits that the After-Filed Figure is not prior art, as the illustration was developed after Applicants filed the present application, and the illustration was developed with Applicants' claims before the Examiner. Assuming *arguendo*, that the After-Filed Figure on page 5 of the Office Action is prior art, the After-Filed Figure does not anticipate any of the pending claims.

**C. No Motivation for Skilled Artisan to Use a Narrow Tray in AFF**

First, the Examiner presumes that the tray shown in the After-Filed Figure exists. Specifically, it is presumed that skilled artisans would be motivated to use trays having a substantially narrower dimension than the channel of Fig. 4 (hereinafter referred to as a Narrow Tray). The Office Action omits any basis for presuming that skilled artisans would use the trays with the clip shown in the After-Filed Figure. Consequently, the reliance on the After-Filed Figure is in error.

**D. The Force Applied in the After-Filed Figure is Concentrated in the Central Area of the Narrow Tray Thereby Damaging the Narrow Trays**

Second, the springs 34 in the After-Filed Figure are curved and have a high point at each center. The force applied by springs 34 is not located on the terminal points of each spring, but instead on the top center or high point of each curve. As a result, springs 34 only contact the central area of the stack in the After-Filed Figure, thereby causing unwanted distortion of the trays. Again, it is erroneous to rely on the After-Filed Figure to reject any of the pending claims.

**E. Hindsight Reconstruction to Reject Claimed Invention is Impermissible**

In summary, the Office Action uses hindsight reconstruction in altering Figure 4 of Applicants' application. However, hindsight reconstruction is an improper basis for rejecting claims.

**F. No Motivation to use a Narrow Tray in AAPA**

Turning now to the acknowledged prior art, AAPA also fails to teach or suggest using a stack that has a dimension that is radically different from the dimension of the base of the channel. AAPA provides no motivation to use a tray whose perimeter partially contacts springs 34. Moreover, it would be uncertain how far to slide a narrow tray into AAPA. It would also be inefficient to substitute narrower trays as fewer components can be transported than with a tray that corresponds to the dimensions of the clip channel. In summary, AAPA does not teach or suggest designing a tray with a smaller dimension than its channel.

**G. Resilient Members Claimed in Claims 2, 4 and 19 are Absent from AAPA**

AAPA also fails to disclose a clip that includes resilient members as recited in Claims 2, 4, and 19. Claim 2 is representative of claims 4 and 19. Claim 2 recites in part: “a first resilient member extending from the base on one end of the channel; and a second resilient member extending from the base on a second end of the channel that is opposite the one end of the channel.” Nothing in AAPA teaches or suggests adding resilient members to each end of AAPA’s channel. Therefore claims 2, 4, and 19 are also novel and nonobvious over AAPA because of their recitation of resilient members.

**H. No Anticipation Possible Since AAPA Fails to Teach each Element of the Invention**

A rejection under 35 USC 102(b) requires that the four corners of a single prior art reference describe every element of the claim such that a person can practice the invention without undue experimentation. Atlas Powder Co. vs. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). AAPA does not anticipate Claims 1 – 4, 16 – 19, 28 -30, 32 and 33 because:

- 1) AAPA does not apply a force to any portion of the perimeter of a stack;
- 2) Resilient Members that extend from the base of a first and second end of the channel are excluded in AAPA’s structure; and
- 3) a narrow tray is neither disclosed nor suggested by AAPA.

Accordingly, Claims 1, 16, and 28, as well as their respective dependent claims are novel over AAPA. Therefore, the Examiner is requested to withdraw the §102(b) rejection of claims 1 – 4, 16 – 19 , 28 -30, 32 and 33.

## **II. Claims 8 -11 are Non-obvious over AAPA or the After-Filed Figure**

Claims 8 – 11 stand rejected under 35 USC 103(a) over AAPA. This rejection is traversed.

Claim 8 recites the apparatus of claim 1 for clamping together in a stack at least one tray that holds integrated circuits, “wherein the apparatus is injection molded in one piece using an injection molding material.” Claim 8, being dependent on claim 1, includes all the novel features of claim 1, discussed above. Accordingly, since claims 8– 11 depend on a patentable independent claim (Claim 1), claims 8 – 11 are also patentable for similar reasons.

Claim 11 is further nonobvious because it claims resilient members that are neither taught nor suggested by AAPA. Specifically, Claim 11 recites “a first resilient member extending from the base on one end of the channel; and a second resilient member extending from the base on a second end of the channel that is opposite the one end of the channel.” Conspicuously, each end of AAPA’s channel lacks any type of resilient member. As a result, AAPA fails to suggest the invention of Claim 11. Therefore, the rejection of Claims 8 -11 under 35 USC 103(a) should be withdrawn.

## **III. Conclusion**

AAPA fails to teach or suggest the claimed invention. First, AAPA fails to disclose resilient members as part of its clip. Second, AAPA does

not disclose or render obvious the application of a force to the perimeter of a stack inserted therein.

The Office Action uses hindsight reconstruction in altering Figure 4 of Applicants' application. However, hindsight reconstruction is an improper basis for rejecting any of the pending claims. AAPA as set forth in Fig. 4 is silent on the use of a tray whose perimeter partially contacts springs 34. Moreover, AAPA does not provide any motivation to use a narrow tray as postulated by the Examiner. Consequently, all of the pending claims are in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Isabelle R. McAndrews', with a stylized flourish at the end.

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Annotated Sheet

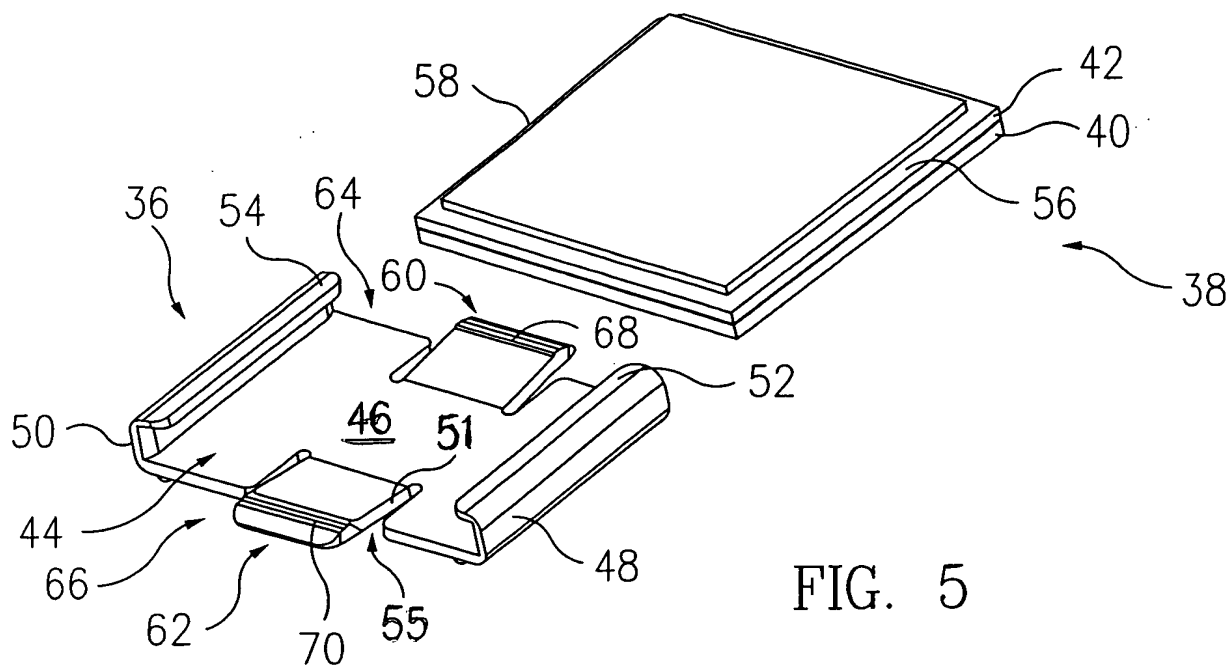


FIG. 5

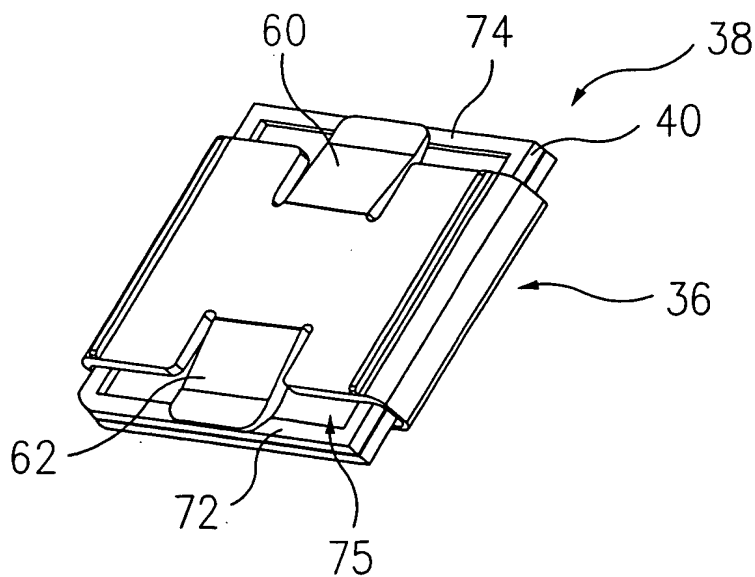


FIG. 6